

### **REMARKS**

Claims 2, 3, 5, 8-21, 39-57 and 61-85 are pending in the above-captioned patent application following this amendment. Claims 7, 8, 20, 30, 45 and 57 were found to contain allowable subject matter. Claims 1-6, 9-19, 21-29, 31-44, 46-56 and 58-60 were rejected. The Applicant respectfully traverses the rejection of claims 53-56, as well as the objection to claim 57. The Applicant has amended claims 2, 3, 5, 8-10, 13-16, 18, 20, 21, 39-43, 45-49, 51-52 and 54 to change dependency, correct obvious typographical or clerical errors and/or in limited cases to clarify what the Applicant regards as the invention, has canceled claims 1, 4, 6-7, 22-38 and 58-60, and has added new claims 61-85, all for the purpose of expediting the patent application process in a manner consistent with the goals of the Patent Office pursuant to 65 Fed. Reg. 54603 (September 8, 2000), even though the Applicant believes that the previously pending claims were allowable.

Support for the amendments to the claims and for the new claims can be found throughout the original application, including the claims, the specification and the drawings. More specifically, new claim 61 is based on previously pending claim 7, which was found to contain allowable subject matter. Further, support for the amendments to claims 2, 3, 5, 8-10, 13-16, 18, 20, 21, 39-43, 46-49, 51-52 and 54 and for new claims 62-84 can be found at least in previously pending claims 1-60, in Figures 3A-3E, 4A-4C and 5A-5C, and in the specification at page 6, line 29 through page 7, line 5, at page 7, lines 11-24, at page 15, line 3 through page 29, line 27.

No new matter is believed to have been added by this response. Consideration of the Application is respectfully requested.

### **Objections to the Claims**

Claims 21, 37 and 54 were objected to because of various informalities. Claims 21 and 54 have been amended as provided above, and claim 37 has been canceled without prejudice by this amendment. Therefore, the objections to claims 21 and 54 are believed to have been overcome, and the objection to claim 37 is believed to be moot.

### **Rejections Under 35 U.S.C. § 102**

Claims 1-6, 10, 12, 23-25, 29, 33-35, 38, 41-44, 47, 48, 53, 55, 56, 58 and 60 are rejected under 35 U.S.C. § 102(b) as being anticipated by Rudell (US 4,390,184). Further, claims 1, 10, 15, 38 and 52 are rejected under 35 U.S.C. § 102(b) as being anticipated by MacIntyre (US 3,143,349). In addition, claims 1, 16, 21, 23, 36, 38 and 49 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stuff Jr. (US 4,423,874). Moreover, claims 1 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP 2001-137400.

As provided above, claims 1, 4, 6, 22-25, 29, 33-35, 38, 58 and 60 have been canceled without prejudice by this amendment. Further, claims 2, 3, 5, 10, 15, 16, 21, 41-43 and 47-48 have been amended as set forth herein. Additionally, claim 12 depends from amended claim 10, and claim 44 depends from amended claim 43. As provided herein, the rejection of these claims is believed to be moot. However, the Applicant respectfully traverses the rejection of claims 53, 55 and 56 on the grounds that the cited reference(s) do not teach or suggest the features of these rejected claims, as provided below.

Rudell is directed toward a golf putter head 15 having a plurality of openings 45, 47, 49 on a base portion 50 of the clubhead 15. Weights, preferably made of lead, are used to at least partially fill the openings 45, 47, 49. (Col. 4, lines 36-39; col. 5, line 63 through col. 6, line 6). Although Rudell teaches that other material for the weights can be used such as mercury, Rudell does not teach or suggest that two different materials be used for the weights within the same putter. (Col. 5, line 63 through col. 6, line 6). Stated another way, Rudell does not teach or suggest using materials having different specific gravities for the weights positioned in the sole of one club head.

In contrast to Rudell, claim 53 is directed toward a method that requires the steps of "forming a first sole insert from a material having a first specific gravity; positioning the first sole insert in a sole region of a putter head of the golf putter; forming a second sole insert from a material having a second specific gravity that is greater than the first specific gravity; and positioning the second sole insert in the sole region of the putter head." These steps are not taught or suggested by Rudell. Thus, Rudell does not

support a rejection of claim 53, and the rejection should be withdrawn, and claim 53 allowed. Because claims 55 and 56 depend directly or indirectly from claim 53, a rejection of these claims based on Rudell is also unsupported and should be withdrawn.

#### **Rejections Under 35 U.S.C. § 103**

Claims 9, 11, 13, 14, 26-28, 31, 32, 39, 40, 46, 51, 54 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rudell. Further, claims 17-19, 37 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stuff Jr. As provided above, claims 26-28, 31, 32 and 59 have been canceled without prejudice by this amendment. Further, claims 9, 39, 40, 46 and 51 have been amended to depend from claims 61, 84, 84, 84 and 84, respectively, which are believed to be allowable. Claims 11, 13 and 14 depend indirectly from claim 61 as a result of the amendments herein.

As provided above, the Applicant respectfully traversed the rejection of claim 53, and submits that claim 53 is allowable. Because claim 54 depends from claim 53, claim 54 is also believed to be allowable.

#### **Allowable Subject Matter / New Claims**

New claims 61-85 have been added by this amendment. New claims 61-85 have a slightly different scope than the previously pending claims. However, in view of the cited references, claims 61-85 are believed to be allowable.

Claim 61 is based on previously pending dependent claim 7, which was found to contain allowable subject matter. The subject matter believed to be allowable from claim 7 has been included in independent claim 61. Thus, claim 61 is believed to be allowable.

The remaining new claims 62-84 are also believed to be allowable in view of the cited references. For example, in addition to Rudell (described previously herein) MacIntyre is directed toward a golf club head having two weight receiving recesses 30, 31, one recess 31 being positioned in the heel portion and the other recess 30 being positioned in the toe portion of the club head. (See Figures 5 and 7, for example). Neither of the weight receiving recesses 30, 31 is positioned so both in the heel portion and the toe portion of the club head. (Figures 5 and 7).

Weight insert members 40 are flat members that are formed from lead, each having a trapezoidal shape similar to that of the recesses 30, 31, in order to prevent rotation of the insert members 40 within the recesses 30, 31. (Col. 3, lines 2-6). The number of weight members 40 can be chosen to give the club the balance desired by the golfer. (Col. 3, lines 9-11; Figure 6). Further, MacIntyre does not teach or suggest using different materials for the insert members 40 within a given club head. In other words, the insert members 40 within a given club head do not have different specific gravities, and different specific gravities than the putter body. Moreover, MacIntyre does not teach or suggest that the volume of each of the recesses is substantially similar to the volume of the respective weight insert members 40 that are positioned within the recesses. (See Figure 6 showing a space in recess 31 not filled with the weight insert members 40).

Additionally, Stuff Jr. is directed toward a golf club head including three weights 26 attached to the underside of the club head with a washer 28 and mounting screw 30. The size of the weights 26 can be varied, although the size of the counterbored recesses 24 that receive the weights 26 are the same. One weight 26 is positioned in the heel region, one weight 26 is positioned in the toe region, and only one weight 26 is positioned partly in the heel region and partly in the toe region. (Figures 2 and 4). The weights each have a larger volume than the volume of the recesses 24 into which they are each positioned. (See Figure 4). Further, the volumes of the recesses 24 are the same as one another. (Figures 2-4).

In contrast to the cited references, new claim 62 requires "a putter body having a centrally positioned transition plane that demarcates the putter body into a heel region and a toe region, the putter body including a sole region that defines a first sole cavity and a second sole cavity, each sole cavity being positioned partly in the heel region and partly in the toe region, the putter body being formed substantially from a material having a first specific gravity; a first sole insert that is inserted into the first sole cavity, the first sole insert being formed substantially from a material having a second specific gravity that is different from the first specific gravity; and a second sole insert that is inserted into the second sole cavity, the second sole insert being formed substantially from a material having a third specific gravity that is different than the first and second

specific gravities.” These features are not taught or suggested by the cited references. Thus, claim 62 is believed to be allowable. Because claims 63-75 depend directly or indirectly from claim 62, these claims are also believed to be allowable.

New claim 76 requires “a putter body having a centrally positioned transition plane that demarcates the putter body into a heel region and a toe region, the putter body including a sole region that defines a first sole cavity having a first volume and a second sole cavity having a second volume that is greater than the first volume; a first sole insert that is positioned with the first sole cavity, the first sole insert having a volume that is approximately the same as the first volume; and a second sole insert that is positioned within the second sole cavity, the second sole insert having a volume that is approximately the same as the second volume.” These features are not taught or suggested by the cited references. Thus, claim 76 is believed to be allowable. Because claims 77-83 depend directly or indirectly from claim 76, these claims are also believed to be allowable.

New claim 84 requires “a putter body having a centrally positioned transition plane that demarcates the putter body into a heel region and a toe region, the putter body including a sole region that defines a first sole cavity having a first volume and a second sole cavity having a second volume that is greater than the first volume, at least one of the sole cavities being positioned partly in the heel region and partly in the toe region, the putter body being substantially formed from a material having a first specific gravity; a first sole insert that is inserted into the first sole cavity; and a second sole insert that is inserted into the second sole cavity.” These features are not taught or suggested by the cited references. Thus, claim 84 is believed to be allowable. Because claims 39-52 depend directly or indirectly from new claim 84, these claims are also believed to be allowable.

New claim 85 requires “a putter body having a substantially centrally positioned transition plane that demarcates the putter body into a heel region and a toe region, the putter body being formed substantially from a material having a first specific gravity, the putter body including (i) a sole region that defines a first sole cavity, (ii) a face region that strikes the ball during putting, and (iii) a back region; a heel weight that is secured

to the heel region, the heel weight being formed substantially from a material having a second specific gravity that is greater than the first specific gravity, the heel weight having a center of gravity; a toe weight that is secured to the toe region, the toe weight being spaced apart from the heel weight, the toe weight being formed substantially from a material having a third specific gravity that is greater than the first specific gravity, the toe weight having a center of gravity; and a first sole insert that is inserted into the first sole cavity, the first sole insert being formed substantially from a material having a fourth specific gravity that is greater than the first specific gravity, the first sole insert having a center of gravity; wherein the center of gravity of the heel weight, the toe weight and the first sole insert form vertices of a triangle that defines a plane that is angled in a downwardly direction moving from the face region toward the back region when the sole insert is in contact with the surface." These features are not taught or suggested by the cited references. Thus, claim 85 is believed to be allowable. Further, claims 2, 3, 5 and 8-21 depend directly or indirectly from new claim 85. Consequently, these claims are also believed to be allowable.

### **Conclusion**

In conclusion, the Applicant respectfully asserts that claims 2, 3, 5, 8-21, 39-57 and 61-85 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-487-4077 for any reason that would advance the instant application to issue.

Dated this 15<sup>th</sup> day of December, 2005.

Respectfully submitted,



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